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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,110

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EXAMINER

KIMBALL, JEREMIAH T

ART UNIT

PAPER NUMBER

3766

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,110	Applicant(s) SUZUKI ET AL.	
	Examiner Jeremiah T. Kimball	Art Unit 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/02/2008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. **Claim 5** recites the limitation "said sexual function" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. Examiner assumes Applicant intended to state "wherein the **method controls a sexual function including** treatment..." Appropriate correction is required. MPEP § 2173.05(e) and MPEP § 608.01.
2. **Claim 1** is objected to because of typographical errors within line 2 of the claim. Examiner assumes Applicant intended to state "...wherein **an** electric field is exposed to **a** whole or a..." Appropriate correction is required. See MPEP § 608.01.

Claim Rejections - 35 USC § 102

3. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office**

action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hara et al. (GB 2,274,593), hereinafter Hara.**
5. In regards to **claim 1**, Hara discloses a nonpharmacological generative function control method of male animals, wherein **[an]** electric field is exposed to **[a]** whole or a part of said male animals with electrodes in a non-contact state with said male animals (Abstract; Pg. 3-5; Fig. 3).

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6. In regards to **claim 3**, Hara discloses wherein said electric field is exposed to at least generative organs of said male animals (Fig. 3).

7. **Claims 1-3 and 5-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Loos (US 6,167,304)**

8. In regards to **claim 1**, Loos discloses a nonpharmacological generative function control method of male animals, wherein **[an]** electric field is exposed to **[a]** whole or a part of said male animals with electrodes in a non-contact state with said male animals (Col. 3, Lines 34-42; Col. 4, Lines 25-39).

9. In regards to **claim 2**, Loos discloses wherein said electric field is a low frequency alternating current electric field (Col. 2, Lines 55-59).

10. In regards to **claim 3**, Loos discloses wherein said electric field is exposed to at least generative organs of said male animals (Col. 6, Lines 32-35).

11. In regards to **claim 5**, Loos discloses wherein the method controls a sexual function including treatment or improvement of erectile dysfunction, ejaculation dysfunction, decrease in libido (i.e. sexual excitement), or lack in orgasm (Col. 6, Lines 32-35).

12. In regards to **claim 6**, Loos discloses a method of controlling sexual behavior (i.e. sexual excitement) of animals using the generative function control method set forth in claim 1 (Col. 6, Lines 32-35).

13. In regards to **claim 7**, Loos discloses a generative function control apparatus for treating or improving sexual dysfunction of male animals, wherein said generative function control apparatus is provided with a pair of electrodes 2 with electric field

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exposable to a whole of a part of said male animals and a power supply (i.e. battery 19) which applies voltage to said pair of electrodes 2 (Col. 5, Line 55 – Col. 6, Line 25; Fig. 1-3).

14. In regards to **claims 8, 9, and 11-13**, claimed subject matter is substantially similar in scope to matter rejected earlier in claims 7, 2, 3, 5, and 1, respectively, above; therefore claims 8, 9, and 11-13 are rejected for at least the same reasons by Loos.

15. In regards to **claim 10**, Loos discloses wherein said apparatus is provided with a power supply controller (i.e. voltage pulse generator 1) in which at least one of applied voltage, frequency, and exposure time can be controlled (Col. 6, Line 62 - Col. 7, Line 17).

16. In regards to **claims 14 and 15**, Loos discloses wherein said male animals are human beings and are mammals (Fig. 1).

Claim Rejections - 35 USC § 103

17. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. **The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:**

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. **Claims 4, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loos.**

20. In regards to **claim 4**, Loos fails to explicitly disclose wherein said electric field is exposed only for a certain time period in a day, which is repeated every day. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize this regimen as Loos does disclose exposure to said electric field for other applications for a certain time period in a day (Col. 5, Lines 43-46) and, similar to any prescribed treatment regimen, it would be obvious to repeat the treatment every day to maximize daily efficacy of the treatment.

21. In regards to **claims 16 and 17**, Loos fails to explicitly disclose wherein said mammals are horses or mice. However, there is no reason to believe said apparatus is incapable of being utilized with horses and mice, and therefore, one of ordinary skill in the art at the time of the invention would be inclined to do so for suitability of purpose.

22. **Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loos in view of Hara.**

23. In regards to **claim 18**, Loos discloses the apparatus of claim 7 except wherein a placing table on which a whole or a part of said male animals can be placed in a stable state is further provided. Attention is directed towards the secondary reference of Hara, which discloses a placing table (i.e. chair 5), upon which male animals can be placed in a stable state (Fig. 3). Loos and Hara are concerned with the same field of endeavor, namely the design of systems and methods for utilizing electric fields for therapeutic

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treatment. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Loos to include a placing table, as taught by Hara, in order to provide a stable state for electric field treatment.

24. In regards to **claims 19 and 20**, Hara discloses wherein said male animals are human beings and said placing table is provided with a back rest portion, a seat plate portion, and a foot rest portion on which human beings can sit and wherein one of said pair of electrodes is arranged upward of a head portion of said human beings by an electrode supporting portion which extends from the back rest portion of said chair and that the other of said pair of electrodes is arranged on said foot rest portion (Fig. 3).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremiah T. Kimball whose telephone number is (571)270-7029. The examiner can normally be reached on 8am-6:30pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl H. Layno can be reached on 571-272-4949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carl H. Layno/
Supervisory Patent Examiner, Art Unit 3766

/Jeremiah T. Kimball/
Examiner, Art Unit 3766
June 22, 2009